

Application No. 10/791,646
Amendment dated December 20, 2006

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Docket No.: 49458DIV (71987)

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REMARKS

Claims 23-31 are pending in the instant application. Claims 1-22 stand cancelled. Claim 23, 26, and 28-31 have been amended to more clearly delineate the claimed invention. Claims 26 and 28-31 have been amended to correct typographical errors. Support for these amendments appears throughout the specification and claims as filed. No new matter is introduced by these amendments.

Applicants make these amendments without prejudice to pursuing the original subject matter of this application in a later filed application claiming benefit of the instant application, including without prejudice to any determination of equivalents of the claimed subject matter.

35 U.S.C. §102 Rejections

Claims 23-27 are rejected under 35 U.S.C. §102(b) as being anticipated by Bartsch et al. (US 4,158,737). It is alleged that Bartsch discloses the vapor phase process of the instant invention,

Applicants traverse, but have amended claim 23 to include the surface area range of from about 100 to 120 m²/g for the porous carrier. Support for the amendment can be found at least at Example 1 of the specification as filed (page 7). In contrast to the instant invention, the surface area of the carrier taught by Bartsch is in the range of 2 to 6 m²/g (Bartsch column 3, lines 55-57). The surface area of 2 to 6 m²/g of Bartsch is clearly distinct from the surface area of about 100 to 120 m²/g, as delineated in the instant application. Applicants contend that Bartsch does not provide for the carrier surface area range of from about 100 to 120 m²/g, as recited in the instant claim 23 as amended, and at least one element of the claimed subject matter is lacking in Bartsch. Bartsch therefore does not anticipate the instant claims. Applicants respectfully request withdrawal of the rejection.

35 U.S.C. §103 Rejections

Claims 23-27 are rejected under 35 U.S.C. §103(a) as being obvious over Bartsch et al. (US 4,158,737). It is alleged that the instant invention is obvious in view of the teachings of Bartsch.

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Applicants disagree and respectfully traverse. The cited references do not teach or suggest the features of the invention in any manner sufficient to sustain the §103 rejection.

For example, see *In re Marshall*, 198 USPQ 344, 346 (CCPA 1978) ("[r]ejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art.") Additionally, it is well-known that to establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference(s) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143.

Claim 23 of the instant application has been amended to include the surface area range of from about 100 to 120 m²/g for the porous carrier. The surface area of the carrier taught by Bartsch is in the range of 2 to 6 m²/g (Bartsch column 3, lines 55-57). Applicants contend that Bartsch does not teach or suggest the carrier surface area range of from about 100 to 120 m²/g, as recited in the instant claim 23 as amended. There is no suggestion or motivation, either in Bartsch or in the knowledge generally available to one of ordinary skill in the art, to modify Bartsch to make the claimed invention, nor is there a reasonable expectation of success. Bartsch fails to provide the necessary motivation or reasonable expectation of success to arrive at a process that will meet the steps of the process delineated in Applicants' claim 23, which includes a surface area range of from about 100 to 120 m²/g for the porous carrier.

The rejection is thus obviated and withdrawal of the rejection is respectfully requested.

In view of the above remarks, Applicants believe the pending application is in condition for allowance. Should any of the claims not be found to be allowable, the Examiner is requested to telephone Applicants' undersigned representative at the number below. Applicants thank the Examiner in advance for this courtesy.

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The Director is hereby authorized to charge or credit any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 04-1105, under Order No. 49458DIV (71987).

Dated: December 20, 2006

Respectfully submitted,

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